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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,832	09/12/2001	Travis J. Parry	10013769-1	8146

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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Fort Collins, CO 80527-2400

EXAMINER

SHINGLES, KRISTIE D

ART UNIT	PAPER NUMBER
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2141

MAIL DATE	DELIVERY MODE
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07/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/954,832

Applicant(s)

PARRY ET AL.

Examiner

Kristie D. Shingles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/24/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

No claims have been amended.

Claims 1-32 are pending examination.

Response to Arguments

I. Applicant's arguments filed 10/24/2006 have been fully considered but they are not persuasive.

Regarding Claims 1, 8, 11, 18, 21 and 24: Applicant argues that the prior art, *Cronch* (US 6,954,278), fails to teach translation of a document file into a second language used by a hard copy generation device or selecting a translator file configured to translate the document file into a second language.

Examiner respectfully disagrees. *Cronch* teaches that if a print job requires an operating system different than the operating system stored in the printer's memory then a host transmits and over-writes the printer's operating system with new operating system (*col.3 lines 14-39*). From *Cronch*'s teaching it is evident that to transmit a new or replacement operating system implies that the applications supported by the printer's original operating system are replaced by a new operating system in order to support the particular print job. Thus the functionality of the claim language is achieved by prior art's teachings. Applicant's arguments are unpersuasive and the rejection is therefore maintained.

Claim Rejections - 35 USC § 102

II. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

III. **Claims 1-4, 8, 11, 18, 21, 24 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by *Cronch et al* (US 6,954,278).**

a. Per claims 1 and 8 (differs by statutory subject matter), *Cronch et al* teach a method for facilitating generation of a hard copy, comprising:

- selecting a document file written in a first language (*Abstract, col.3 lines 3-7*);
- selecting a translator configured to translate the document file into a second language of specialized commands for a hard copy generation device, the specialized commands enabling a hard copy of the document file to be produced at the hard copy generation device (*Abstract*); and
- packaging the document file and the translator file together in a job package that can be received by the hard copy generation device (*col.2 lines 5-10, col.3 lines 24-42*).

b. Per claims 11 and 18 (differs by statutory subject matter), *Cronch et al* teach a method for generating a hard copy, comprising:

- receiving a job package comprising a document file representing a document, the document file written in a first language, and a translator configured to translate the document file into a second language of specialized commands for producing a hard copy of the document file at a hard copy generation device (*Abstract, col.3 lines 3-7*);
- opening the job package (*col.3 lines 30-32*);

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- using the translator to translate the document file into the second language (*Abstract*); and
- generating a hard copy of the document (*col.2 lines 5-10, col.3 lines 24-46*).

c. **Claims 21 and 24** contain limitations that are substantially similar to claims 1, 8, 11 and 18 and are therefore rejected under the same basis.

d. **Per claim 2**, *Cronch et al* teach the method of claim 1, wherein selecting a document file comprises selecting a document file identified by a user (*col.3 lines 3-7*).

e. **Per claim 3**, *Cronch et al* teach the method of claim 1, wherein the step of selecting a translator comprises selecting a translator identified by a user (*col.3 lines 3-7*).

f. **Per claim 4**, *Cronch et al* teach the method of claim 1, further comprising the step of transmitting the job package to the hard copy generation device (*col.2 lines 5-10, col.3 lines 24-46*).

g. **Claim 29** is substantially similar to claim 4 and is therefore rejected under the same basis.

Claim Rejections - 35 USC § 103

IV. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

V. **Claims 5, 16, 17, 22 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Cronch et al* (US 6,954,278) in view of *Vidyanand* (US 6,967,728).**

a. **Per claim 5**, *Cronch et al* teach the method of claim 1, yet fails to explicitly teach the step of transmitting the job package to a recipient computing device. However *Vidyanand* teaches transmitting the printer driver and file to another user computer in addition to a printing device (*col.2 line 63-col.3 line 3, col.4 lines 46-55, col.5 lines 16-22 and 28-36, col.8 lines 5-55*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Cronch et al* and *Vidyanand* for the purpose of allowing printing preferences to be exchanged and transferred across the network from one computer to another.

b. **Claims 22, 25 and 27** is substantially similar to claim 5 and are therefore rejected under the same basis.

c. **Per claim 26**, *Vidyanand* teach the method of claim 1, further comprising transmitting the job package over a network as an email attachment (*col.4 lines 56-58*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Cronch et al* and *Vidyanand* for the purpose transmitting the job package over the network using electronic communication means.

d. **Per claim 16**, *Vidyanand* teach the method of claim 11, further comprising the step of registering with a remote computing device prior to generating the hard copy (*col.3 lines 1-3, col.5 lines 19-22; print server*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Cronch et al* and *Vidyanand* for the purpose registering the print job with a server in order to organize, schedule and transmit the print jobs to the appropriate printer devices.

e. **Per claim 17**, *Vidyanand* teach the method of claim 16, wherein the step of generating a hard copy is enabled by the remote computing device (*col.5 lines 19-22; print server controls printing to networked printers*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Cronch et al* and *Vidyanand* for the purpose registering the print job with a server in order to organize, schedule and transmit the print jobs to the appropriate printer devices.

VI. Claims 6, 7, 9, 10, 12-15, 19, 20, 23, 28, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Cronch et al* (US 6,954,278) and *Vidyanand* (US 6,967,728) in further view of *Adamske et al* (US 6,615,234).

a. **Per claim 6**, *Cronch et al* teach the method of claim 1 as applied above, yet fails to explicitly teach method of claim 1, further comprising the step of encrypting the job package. However, *Adamske et al* disclose encryption of the translated document prior to delivery (*col.3 line 64-col.4 line 8*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Cronch et al* with *Adamske et al* for the purpose of provisioning security and the integrity of the document through the network by implementing encryption.

b. **Claims 9, 12 and 28** are substantially similar to claim 6 and are therefore rejected under the same basis.

c. **Per claim 32**, *Cronch et al* teach the method of claim 21 as applied above, yet fails to explicitly teach the method of claim 21, wherein receiving an address comprises receiving a universal resource locator (URL) that identifies the location of the job package. However, *Adamske et al* disclose use of a URL for locating the document. *Adamske et al* teach encryption, and it is therefore intrinsic and obvious (in order to achieve effective

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communication) to provision a method of decryption along with encryption, in order for the document/data to be comprehensible to the appropriate recipient. Furthermore, *Adamske et al* restrict access to the encrypted documents by implementing security features with electronic signatures, pass phrases and user IDs that prohibit access of the document until authentication of the signatures, wherein the document will be decrypted for receipt and viewing once the authentication has been satisfied (*col.6 lines 1-23 and col.8 line 24-col.9 line 32*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Cronch et al* with *Adamske et al* for the purpose of provisioning a decryption method along with an encryption method for making content accessible to the recipient and to furthermore utilize URLs as locators for documents, since URL provide access to electronic documents, data and media on the web/Internet.

d. **Claims 7, 10, 13-15, 19, 20, 23 and 30** contain limitations that are substantially similar to claim 32 and are therefore rejected under the same basis.

VII. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Cronch et al* (US 6,954,278) and *Vidyanand* (US 6,967,728) and in further view of *Nakamura et al* (US 6,064,836).

Per claim 31, *Cronch et al* and *Vidyanand* teach the method of claim 16 as applied above, yet fail to explicitly teach the method of claim 16, wherein registering comprises registering with a remote computing device for the purpose of determining whether a total number of hard copies have already been generated and, if so, prohibiting generation of a further hard copy. However, *Nakamura et al* teach the determination of the number of generated copies and the prohibition of addition hard copies being made (*col.1 line 40-col.2 lines 10, col.4 lines*

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25-51, col.6 lines 31-67, col.7 line 41-col.8 line 12, col.9 line 66-col.10 line 60, col.11 lines 48-56, col.12 lines 52-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Cronch et al* and *Vidyanand* with *Nakamura et al* with for the purpose of provisioning monitoring/tracking of the number of hard copies generated/printed in order to properly process the document/data in its entirety; because it allows for management of hard copy generation.

Conclusion

VIII. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Shiohara (6,804,019), Nakazato (6,891,631), Simpson et al (6,781,710), Jecha et al (6,247,011), Soga (6,476,938), deBry et al (6,538,760).

IX. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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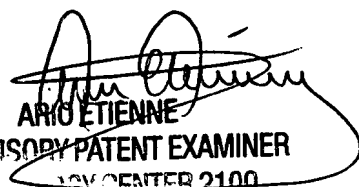
X. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie D. Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday 8:00am-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie D Shingles
Examiner
Art Unit 2141

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